The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STEPHEN MICHAEL REUNING

Appeal No. 2004-1714
Application No. 09/897,826

ON BRIEF

Before HAIRSTON, KRASS, and NAPPI, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a decision dated September 30, 2004, the Board affirmed the 35 U.S.C. § 102(e) rejection of claims 1 through 19 based upon the teachings of the patent to McGovern.

The subject application is a continuation of Application Number 08/984,650. An affidavit under 37 CFR § 1.131 was submitted by the appellant in Application Number 08/984,650 to antedate the effective filing date of the McGovern patent. As indicated in our decision, the examiner granted appellant's affidavit request, and the parent application issued as U.S. Patent Number 6,381,592. The same affidavit was

submitted in the subject application to antedate the McGovern patent. Appellant argued (supplemental brief, page 6; reply brief, pages 4 and 5) that the Office should abide by the findings made by the examiner in the parent application, and withdraw the McGovern patent as a reference in the subject application.

The Board found that "the claims on appeal differ from the claims allowed in the parent application," "the examiner had both the right and the duty to take a fresh look at the affidavit based upon the claimed invention in the subject application," and "the affidavit never specifically mentions the limitations of the claims before us on appeal" (decision, page 3). The Board agreed with the examiner's finding that the affidavit was "inconclusive in a determination of whether or not the claimed invention was conceived at [a] date prior to the effective filing date of McGovern et al." (decision, page 4). Thus, the affidavit failed to antedate the McGovern patent in the subject application.

Appellant now argues (request, pages 2 and 3) that the Board erred in not antedating the McGovern patent because claim 1 in the subject application is the same as claim 18 in the parent application. Appellant's arguments to the contrary notwithstanding, claim 1 differs substantially from parent claim 18. To be more exact, claim 1 on appeal seeks to locate "an individual with specifically defined professional qualifications," whereas parent claim 18 seeks to locate "an Internet site page or web posting which contains operator specified text comprising specifically defined experiences." Claim 1 on appeal specifically requires "a filter" to perform the search,

but parent claim 18 is silent as to such a filter. In view of these differences, the claims are not the same, and the examiner properly examined the claims on appeal as claims newly presented in the subject continuation application.

The appellant argues (request, page 3) that the examiner in the subject application should be bound by the findings made in the parent application, and that 'the Board should not condone the Examiner's arbitrary and capricious change in position."

Since the claims on appeal differ from the claims in the subject application, the examiner was not acting in an "arbitrary and capricious" manner when he examined each claim in the subject application on it own merits. As indicated supra, the examiner's findings in the parent application are not binding on the examiner because he had a right and a duty to take a fresh look at the newly presented claims on appeal. The U.S. Patent and Trademark Office and the examiners employed to examine applications are not bound to repeat in the subject application an error or errors that may have been made in the parent application. Ex parte Tayama, 24 USPQ2d 1614, 1618 (Bd. Pat. App. & Int. 1992).

Appellant's request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

DENIED

KENNETH W. HAIRSTON
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
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